

The opinion in support of the decision being entered today is *not* binding
precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL ENGLAND

Appeal 2007-1882
Application 09/507,191
Technology Center 2100

Decided: September 25, 2007

Before KENNETH W. HAIRSTON, ANITA PELLMAN GROSS,
and JEAN R. HOMERE, *Administrative Patent Judges*.
HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from a final rejection of
claims 43 and 45 to 62. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

Appellant has invented a method and system for verifying that a computer-readable media (e.g., a CD or DVD) is an original data storage medium. A verification module randomly retrieves blocks of data from the CD or DVD, and performs a digest operation on the retrieved data. A digest operation is a cryptographic operation that processes a block of data such that the resulting digest is smaller in size than the original block of data. After performing the digest operation on the retrieved data, the verification module compares the result of the digest operation to known verification data contained in a digest. The CD or DVD is presumed to be valid if the retrieved data matches the corresponding known verification data. (Figures 1 and 2; Specification 4, 9, and 10).

Claim 43 is representative of the claims on appeal, and it reads as follows:

43. A method comprising:

randomly retrieving a plurality of blocks of data from a computer-readable media, wherein at least one block of data includes data not contained in a given content¹;

generating a digest value for each of the plurality of randomly retrieved blocks of data;

comparing each of the digest values to a set of verification data;

¹ Neither the disclosure nor the briefs shed any light on the meaning of the phrase “wherein at least one block of data includes data not contained in a given content.”

determining that the computer-readable media contains an original version of the given content if the digest values match a subset of the verification data; and

allowing access to a functionally equivalent version of the given content, which is smaller than the original version, if the digest values match a subset of the verification data.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Herzberg	US 5,745,678	Apr. 28, 1998
Ansell	US 6,367,019 B1	Apr. 2, 2002 (filed Mar. 26, 1999)

The Examiner rejected claims 43 and 45 to 62 under 35 U.S.C. § 103(a) based upon the teachings of Ansell and Herzberg.

Appellant contends *inter alia* that the applied references, whether considered separately or in combination, do not teach or suggest randomly retrieving a plurality of blocks of data from a computer-readable media, generating a digest value for each of the plurality of randomly retrieved blocks of data, determining that the computer-readable media contains an original version of the given content if the digest values match a subset of the verification data, and allowing access to content if the digest values match a subset of the verification data (Br. 8 and 9).

ISSUE

Does the applied prior art teach or would have suggested to the skilled artisan all of the features of the claimed invention?

FINDINGS OF FACT

As indicated *supra*, Appellant describes a method and system for randomly retrieving blocks of data from a computer-readable media, generating a digest value for each of the plurality of randomly retrieved blocks of data, and comparing each of the digest values to a set of verification data. If the digest values match a subset of the verification data, the computer-readable media is deemed to be an original version of the content, and access is allowed to a functionally equivalent version of the content.

Ansell describes a method and system in which data such as a musical track is stored as a secure portable track (SPT), and is bound to one or more external players and to a particular storage medium in which the SPT is stored (Abstract; col. 3, ll. 60 to 64). The musical track can only be played back from the original storage medium and on the specific external players (Abstract; col. 3, l. 64 to 66). The SPT is bound to a specific external player by encrypting data of the SPT using a storage key that is unique to the player (Abstract; col. 6, ll. 33 to 36).

Ansell uses a computer 100 that includes a music player 110 and a SPT interface 114 (Figure 1; col. 4, ll. 5 to 27). The player 110 receives musical tracks 112 from the network 170, and the SPT interface 114 creates SPTs 116 from tracks 112 and downloads the SPTs to portable music player 150 (col. 5, ll. 1 to 12). As indicated *supra*, the SPTs 116 are bound to both the storage medium (e.g., storage medium 202) on which the SPTs are stored, and to one or more specific external players (e.g., portable music player 150) (Figure 2; col. 5, ll. 20 to 23). The binding encryption of an SPT renders the music on the track useless for play on a player that is not

specified in the encryption, and the SPT will not play when it is copied to a different storage medium (col. 5, ll. 40 to 45).

Each of the SPTs includes a header 302, and each of the headers in turn includes a binding 400 (Figures 3 and 4; col. 5, ll. 51 to 65). Each of the bindings 400 includes a media identification field 402, a media type and information field 404, a storage key identification field 406 that stores data identifying the storage key (i.e., the key with which the substantive content of SPT 116 is encrypted, and, as indicated *supra*, is the key allocated to a specific external player), an encrypted media master key field 408 that stores data representing an encrypted representation of the key by which the content of SPT 116 is encrypted, and a binding message authentication code (MAC) field 410 for fields 402 to 408 (col. 5, l. 65 to col. 6, l. 65).

The storage key identification field 406 stores a digest of the storage key to identify the storage key (col. 6, ll. 51 to 53).

The Examiner cited the reference to Herzberg for at least a teaching of “*randomly retrieving a plurality of blocks of data from a removable medium* (CD ROM) to determine if the content is valid (see column 7, lines 11-18 and column 5, lines 58-60 and column 2, lines 9-14)” (Answer 5).

PRINCIPLES OF LAW

The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The Examiner’s articulated reasoning in the rejection must possess a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

“One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

In an obviousness rejection, it is impermissible “to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965).

ANALYSIS

It is abundantly clear from the findings of fact that the applied references neither teach nor would have suggested to one of ordinary skill in the art randomly retrieving blocks of data from a storage medium, generating a digest value for each of the plurality of randomly retrieved blocks of data, and comparing each of the digest values to a set of verification values to determine if the storage medium contains an original version of content, and to allow access to a version of the content as set forth in the claims on appeal. The noted digest of keys used by Ansell to encrypt data of the SPT is not a “digest value” for each of randomly retrieved blocks of data. Even if we assume for the sake of argument that the claimed digest value and the digest of keys in Ansell are synonymous, Ansell, as well as Herzberg, lacks a teaching of comparing a digest value to a set of verification data as set forth in the claims on appeal. Accordingly, we agree with the Appellant’s arguments throughout the briefs that the claimed invention is neither taught by nor would have been suggested by the applied references.

CONCLUSION OF LAW

In the obviousness rejection, the Examiner used impermissible hindsight reconstruction to pick and choose among disclosures in the applied prior art references. Obviousness has not been established by the Examiner because the applied references neither teach nor would have suggested to the skilled artisan all of the method steps and system limitations.

DECISION

The obviousness rejection of claims 43 and 45 to 62 is reversed.

REVERSED

KIS

LEE & HAYES, PLLC
421 W. RIVERSIDE AVENUE
SUITE 500
SPOKANE, WA 99201